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Paper No. 16

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MAILED

MAR 17 2011

OFFICE OF PETITIONS

In re Patent No. 5,934,314 :
Issue Date: 08/10/1999 :
Application Number: 08/982,694 : LETTER DISMISSING PETITION
Filing Date: 12/02/1997 :
Attorney Docket Number: 243755 :
:

This is a letter in reference to the paper filed on December 28, 2010, regarding a maintenance fee payment intended for the above-referenced patent, which is treated as a petition under 37 CFR 1.377.

The petition is dismissed for the reasons stated below.

The paper states, in pertinent part:

Today I paid the third maintenance fee online in the amount of \$4,110.00 for U.S. Patent No. 5,935,314 in error. ... Payment was intended to be made for U.S. Patent No. 5,934,314.

(emphasis in original)

As stated in MPEP 2575, 37 CFR 1.377 provides a mechanism for review of a decision refusing to accept and record payment of a maintenance fee filed prior to the expiration of a patent. 37 CFR 1.377(a) permits a patentee who is dissatisfied with the refusal of the Office to accept and record a maintenance fee which was filed prior to the expiration of the patent to petition the Director to accept and record the maintenance fee. Any petition filed under 37 CFR 1.377 must be filed within 2 months of the action complained of, or within such other time as may be set in the action complained of. The petition must be accompanied by the proper petition fee (37 CFR 1.17(g)). The petition may include a request that the petition fee be refunded if the refusal to

accept and record the maintenance fee is determined to have resulted from an error by the Office.

A petition fee of \$200.00 is required upon filing of a petition under 37 CFR 1.377. Patent and trademark fees and charges payable to the Patent and Trademark Office are required to be paid in advance, that is, at the time of requesting any action by the Office for which a fee or charge is payable.¹ As such, the petition fee is a prerequisite to the filing of the present petition, and the Office will not reach the merits of the petition unless and until the petition fee is submitted. Any request for reconsideration of this petition must be accompanied by the petition fee.

Furthermore, the papers filed are not properly signed. 37 CFR 1.377 requires that any petition filed thereunder must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest. The present paper does not appear to have been signed by a proper party.

Still further, MPEP 2580 states, in pertinent part:

37 CFR 1.377 provides a mechanism for review of a decision refusing to accept and record payment of a maintenance fee filed prior to the expiration of a patent. 37 CFR 1.377(a) permits a patentee who is dissatisfied with the refusal of the Office to accept and record a maintenance fee which was filed prior to the expiration of the patent to petition the Director to accept and record the maintenance fee. This petition may be used, for example, in situations where an error is present in the identifying data required by 37 CFR 1.366(c) with the maintenance fee payment, i.e., either the patent number or the application number is incorrect. See MPEP § 2515 and § 2530. A petition under 37 CFR 1.377 would not be appropriate where there is a complete failure to include at least one correct mandatory identifier as required by 37 CFR 1.366(c) for the patent since no evidence would be present as to the patent on which the maintenance fee was intended to be paid. If the maintenance fee payment with an incorrect mandatory identifier was made near the end of the grace period, the patent might expire since the Office would

¹ 37 CFR 1.22(a).

not credit the fee to the patent. A petition under 37 CFR 1.377 would not be appropriate where the patentee paid a maintenance fee on one patent when the patentee intended to pay the maintenance fee on a different patent but through error identified the wrong patent number and application number.

Accordingly, any petition under 37 CFR 1.377 should be accompanied by proof that the appropriate identifying information accompanied the payment.

Lastly, in regards to the request for a refund of the maintenance fee payment, 37 CFR 1.26 states, in pertinent part, that the Director may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent filing for which the fee was paid, will not entitle a party to a refund of such fee.

In the absence of either of the mandatory identifiers as set forth in MPEP 2580, there is insufficient evidence to conclude that the fee was paid by mistake or in excess of that required. Rather, the showing of record is of a change in purpose (*i.e.*, from U.S. Patent No. 5,935,314 to U.S. Patent No. 5,934,314.) Any request for refund must show that the fee was paid by mistake or in excess of that required.

The address in the subject letter is different than the correspondence address of record. A copy of this decision will be sent to the address in the petition. All future correspondence, however, will be mailed solely to the address of record. A change of correspondence address should be filed if the correspondence address needs to be updated.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

By hand: Customer Service Window
 Mail Stop Petition

Randolph Building
401 Dulany Street
Alexandria, VA 22314

The application will be retained in the Office of Petitions for TWO (2) MONTHS to await petitioners' response to this communication.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3231.



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